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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,823	09/18/2001	Edward L. Beery II		8192
32099	7590	01/17/2006		
EDWARD L. BEERY II			EXAMINER	
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CENTENIAL, CO 80121				
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/954,823	BEERY, EDWARD L.
	Examiner	Art Unit
	Tri V. Nguyen	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 September 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) 8 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 September 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/26/2001</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to because of the following informalities: the numbering within claim 8 is inconsistent , (h) should be (b), (b) should be (c), etc. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 4, 7 and 8 disclose a "method" in the preamble but use the language of "(means for)" in the body, it is unclear as whether a method (preamble) or means (body) is claimed. Claims 3-4 and 5-6 are dependent claims of claim 1 and 2 respectively; therefore, claims 3-4 and 5-6 show the same deficiency. For examination purposes, claims 1-8 have been treated as method claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by the website www.couponsurfer.com (hereon referred as couponsurfer). Furthermore, the website

www.couponsolutions.com (hereon referred as couponsolutions) describes the website www.couponsurfer.com.

Regarding claim 1, couponsurfer and couponsolutions disclose a method for delivery of a promotional offer to a consumer comprising;

(a) (*means for*) storing criteria for said promotional offer (couponsurfer: page 5 and couponsolutions: pages 9-11);

(b) providing a computer printer (couponsurfer: page 9, §2 and §6);

(c) (*means for*) storing content of a consumer created order (couponsurfer: page 6; 7, §3; 8, §9 and 9, §1);

(d) (*means for*) identifying said promotional offer where said criteria of said promotional offer have been met based on said content of a consumer created order (couponsurfer: page 6; 7, §3; 8, §8-9 and 9, §1);

(e) providing a display for the display of said promotional offer where said criteria of said promotional offer have been met (couponsurfer: page 6; 7, §3; 8, §9 and 9, §1);

(f) (*means for*) consumer to select said promotional offer by review of said display of said promotional offer (couponsurfer: page 5 and 9, §2-3);

(g) (*means for*) printing the consumer selected promotional offer via said computer printer (couponsurfer: page 9, §2, §6); and

whereby said computer printer prints said promotional offer solely in response to the consumer's selection of the promotional offer (couponsurfer: page 9, §2, §6).

Regarding claim 2, couponsolutions discloses the method of claim 1 wherein the printed promotional offer has a machine-readable barcode (couponsolutions: pages 5, 6, 9-11).

Regarding claim 3, couponsolutions discloses the method of claim 1 wherein the printed promotional offer does not have a machine-readable barcode (couponsolutions: pages 9-11 [especially on page 11, step IV as the bar code is optional]).

Art Unit: 3622

Regarding claim 4, couponsurfer and couponsolutions disclose a method for delivery of a promotional offer to a consumer comprising;

- (a) (*means for*) storing criteria for said promotional offer (couponsurfer: page 5 and couponsolutions: pages 9-11);
- (b) providing a computer printer (couponsurfer: page 9, §2 and §6);
- (c) (*means for*) storing content of a consumer created order (couponsurfer: page 6; 7, §3; 8, §9 and 9, §1);
- (d) (*means for*) identifying said promotional offer where said criteria of said promotional offer have been met based on said content of a consumer created order (couponsurfer: page 6; 7, §3; 8, §8-9 and 9, §1);
- (e) (*means for*) printing said promotional offer via said computer printer (couponsurfer: page 9, §2, §6); and

whereby the printing of said promotion is solely in response to said criteria of said promotional offer having been met (couponsurfer: page 9, §2, §6).

Regarding claim 5, couponsolutions discloses the method of claim 4 wherein the printed promotional offer has a machine-readable barcode (couponsolutions: pages 5, 6, 9-11).

Regarding claim 6, couponsolutions discloses the method of claim 4 wherein the printed promotional offer does not have a machine-readable barcode (couponsolutions: pages 9-11 [especially on page 11, step IV as the bar code is optional]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the website www.couponsurfer.com (hereon referred as couponsurfer) and the website www.couponsolutions.com (hereon referred as couponsolutions) describing the website www.couponsurfer.com further in view of Golden et al. (5,761,648).

Regarding claim 7, couponsurfer and couponsolutions disclose a method for delivery of a promotional offer to a consumer comprising;

- (a) (*means for*) storing criteria for said promotional offer (couponsurfer: page 5 and couponsolutions: pages 9-11);
- (b) (*means for*) storing consumer information (couponsurfer: page 6; 7, §5 and 15, §3);
- (c) (*means for*) storing content of a consumer created order (couponsurfer: page 6; 7, §3; 8, §9 and 9, §1);
- (d) (*means for*) identifying said promotional offer where the criteria of the promotional offer have been met based on the said content of a consumer created order (couponsurfer: page 6; 7, §3; 8, §8-9 and 9, §1);
- (e) providing a display for the display of said promotional offer where said criteria of said promotional offer have been met (couponsurfer: page 6; 7, §3; 8, §9 and 9, §1);
- (f) (*means for*) consumer to select said promotional offer by review of said display of said promotional offer (couponsurfer: page 5 and 9, §2-3);

but do not explicitly teach (g) (*means for*) storing the selected promotional offer; whereby the storage of said promotional offer is solely in response to the consumer's selection of the promotional offer; and

whereby the stored consumer-selected promotional offer may be retrieved electronically for use at a retail store. However, in an analogous art, Golden et al. discloses a method for delivering coupons via a network wherein the coupons can be saved on the computer of the user to be printed at a later time or sent via a network to be validated at the retail outlet (col 3, line 65 to col 4, line 39 and col 5, lines 43-63). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user to download and save the electronic coupon to be printed or send the

coupon to the retail outlet for later retrieval. One would have been motivated to allow for storing the coupon at the user's computer since the user will have more scheduling flexibility as the user can print the coupon at a more convenient time or on several occasions. Furthermore, one would have been motivated to allow for the electronic delivery of the promotional offer to the store to eliminate the need for printing and physically carrying the coupon.

Regarding claim 8, couponsurfer and couponsolutions disclose a method for delivery of a promotional offer to a consumer comprising;

- (a) (*means for*) storing criteria for said promotional offer (couponsurfer: page 5 and couponsolutions: pages 9-11);
- (h) (*means for*) storing consumer information (couponsurfer: page 6; 7, §5 and 15, §3);
- (b) (*means for*) storing content of a consumer created order (couponsurfer: page 6; 7, §3; 8, §9 and 9, §1);
- (c) (*means for*) identifying said promotional offer where said criteria of said promotional offer have been met based on said content of a consumer created order (couponsurfer: page 6; 7, §3; 8, §8-9 and 9, §1); whereby the storage of said promotional offer is solely in response to said criteria of said promotional offer having been met (couponsurfer: page 9, §2, §6); but do not explicitly teach (d) (*means for*) storing the identified promotional offer; and whereby the promotional offer may be retrieved electronically for use at a retail store. However, in an analogous art, Golden et al. discloses a method for delivering coupons via a network wherein the coupons can be saved on the computer of the user to be printed at a later time or sent via a network to be validated at to the retail outlet (col 3, line 65 to col 4, line 39 and col 5, lines 43-63). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user to download and save the electronic coupon to be printed or send the coupon to the retail outlet for later retrieval. One would have been motivated to allow for storing the coupon at the user's computer since the user will have more scheduling flexibility as the user can print the coupon at a more convenient time or on several occasions. Furthermore, one would have been motivated to allow for the electronic delivery

Art Unit: 3622

of the promotional offer to the store to eliminate the need for printing and physically carrying the coupon.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - A. Engel et al. (5,907,830) discloses an electronic coupon distribution system wherein the consumer can search a database, download and print coupons.
 - B. Scroggie et al. (5,970,469) discloses a system and method for providing shopping aids and incentives to customers through a computer network wherein the consumer establish a shopping list and matching coupons to be printed.
 - C. Fajkowski (5,905,246) discloses a method for coupon management and redemption wherein the user download electronic coupon to be printed at home or at the retail store.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

nvt



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